

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated June 1, 2005, in which:

- claims 1-37 are rejected under 35 U.S.C. § 102(e) on Hendricks *et al.* (hereafter, 'Hendricks,' US Patent No. 6,539,548 B1).

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

Claims 1-37 are now pending the above referenced patent application. No claims have been amended, cancelled, or added. No new matter has been entered.

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

1. 35 U.S.C. § 102

1.1. Official Notice

It is noted that the Office Action does not cite the term Official Notice within the summary or detailed explanation of the rejection of the claims. However, in the "Response to Arguments" section (pages 7 & 8) the PTO appears to informally take Official Notice. This informal attempt to take Official Notice is respectfully traversed.

The PTO appears to take Official Notice of the following:

it is well known in the art and based on the Examiner's actual experience through subscription to cable services and personal knowledge, that the television and cable services offer to the user for at least a substantial (*sic*) same number of channels either in analog or digital services, for example (every one knows), a CNN channel providing in analog for a less fee (*sic*) might be also offered in a standard digital service or HDTV for an enhanced feature (video and sound) for a relatively more expensive fee for better enjoying (*sic*) in visual and sound effects

1.1.1. Request for Clarification

Applicants are unsure if the PTO intended to base a rejection on this Official Notice. If so, Applicants are unsure which claims are rejected based upon this Official Notice versus the cited Hendricks reference, or if Official Notice was actually taken. If the PTO claims that Hendricks shows all the features of the Applicants' claim, why is the Official Notice mentioned?

Clarification is requested.

1.1.2. Request for Documentation

Applicants respectfully assert that M.P.E.P. § 2144.03(C) requires that "the Examiner Must Support the Finding With Adequate Evidence." From M.P.E.P. § 2144.03(B) "Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection)". Applicants respectfully request this evidence.

Applicants are understandably leery of traversing a § 102 rejection based upon something that "every one knows". There are many things that "every one knows" that are wrong. Furthermore, things that "every one knows" tend to be malleable. It is respectfully requested that, if the PTO wishes to maintain this Official Notice, a document be provided that is more concrete and allows the Applicants and PTO a common understanding of the issues in question.

To aid in this, the Applicants have provided, via Information Disclosure Statement, a Comcast advertisement that shows a tiered channel package scheme. If the Comcast advertisement illustrates the point the PTO is attempting to make, it is respectfully requested that any Official Notice be withdrawn and the Comcast advertisement, another document, or Hendricks alone (which also shows a tiered channels scheme) be used by the PTO instead.

1.1.3. Conclusion

As detailed in M.P.E.P. § 2144.03, the standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Applicants respectfully request that the PTO furnish documentary evidence showing prior art that alone or in combination meets all the elements of the Applicants' claimed subject matter and showing why one skilled in that art would be motivated to combine the subject matter of the other cited art.

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

1.2. Hendricks: Claims 1-37

The PTO has rejected claims 1-37 under 35 U.S.C. § 102(b) as being anticipated by Hendricks. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 1. Claim 1 recites:

- 1 1. (Original) A method comprising:
- 2 receiving information regarding a plurality of different entertainment programs
- 3 and a plurality of different upgraded media features associated with each entertainment
- 4 program;
- 5 displaying at a user terminal a list of entertainment programs and, for each
- 6 entertainment program, a plurality of different upgraded media features;
- 7 transmitting an entertainment program selection together with one or more
- 8 upgraded media feature selections from the displayed plurality to an entertainment
- 9 program provider;
- 10 receiving the selected entertainment program with the selected upgraded media
- 11 features.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Hendricks does not show, teach, use, or describe a plurality of different upgraded media features associated with each entertainment program.

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

Hendricks instead shows presenting the user with a tiered package of channels. See Hendricks, Fig 25a.

1.2.1. With Each Entertainment Program

It is respectfully asserted that the primary error in the § 102 rejection lies in a misunderstanding of the Applicants disclosed matter. Applicants' Fig. 5 may aid in the understanding of the disclosed matter.

As seen in Fig. 5, a single program is offered (*e.g. Titanic*) but it is offered with a variety of features ("upgraded media features"), such as, for example, various video resolutions (*e.g. 640x480, HDTV, etc.*) and audio qualities (*e.g. 2 speaker, 5.1 surround, 7.1 surround*). Hendricks on the other hand, specifically the portion cited by the PTO, offers different channels. It is respectfully asserted that channels are not programs.

Applicants' claim 1, lines 3 & 4 clearly require "a plurality of different upgraded media features associated with each entertainment program". The PTO states Hendricks "Figs. 14-16 shows menus of available programs". Applicants respectfully assert that Hendricks does not show "programs"; Hendricks instead shows "channels".

Applicants begin with the definition of "program":

program (pro'gram', -grem) noun

1. a. A listing of the order of events and other pertinent information for a public presentation.
b. The presentation itself: a program of piano pieces.

2. A scheduled radio or television show.

The American Heritage Dictionary of the English Language, Third Edition © 1996 by Houghton Mifflin Company. (emphasis added)

Applicants contrast that with the definition of "channel":

channel (chàn'el) noun

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

Abbr. chan.

1. ...

8. Electronics. A specified frequency band for the transmission and reception of electromagnetic signals, as for television signals.

The American Heritage Dictionary of the English Language, Third Edition © 1996 by Houghton Mifflin Company. (*emphasis added*).

It is asserted that Hendricks clearly deals with channels, not programs. Hendricks' Fig. 14 (cited by the PTO) shows a column referred to as "CHANNELS" on the upper right-hand corner of the figure. Confirming that these channels are "a specified frequency band for the transmission and reception of ... television signals" is the left-hand column of Fig. 14 that shows a mega-Hertz ("mHz" (sic)) range from 0 to 750. It is respectfully asserted that at no point in time does Hendricks refer or discuss specific, single individual "television show[s]", i.e. programs, with different features.

Applicants will concede that Hendricks does show a channel that allows a user to purchase a la carte programs. See Fig. 29a. But neither this channel nor the a la carte programs on this channel has a plurality of features associated with each program. See 1.2.2 Upgraded Media Features below. Therefore, Applicants respectfully contend that Fig 29a of Hendricks also fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Applicants will concede that Hendricks does discuss channels with features that differ from other channels, but that is not what Applicants claim. Applicants claim "programs" not "channels". Furthermore, Applicants claim "each program" not a "group of programs". Therefore, it is respectfully asserted that the failing in the cited art could not be corrected by simply arguing that a channel is merely a "group of programs"¹. As just one failing of the cited art, the difference is in the level of granularity. Therefore, Applicants respectfully contend that

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

Hendricks, for at least his reason, fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

An analogy may prove illustrative. It is as if the Applicants invention dealt with having multiple versions of a car model (program). One could purchase the Honda Accord Coupe, Honda Accord Sedan Value Package, Honda Accord Sedan LX, Honda Accord Sedan EX, or Honda Accord Sedan Hybrid. All versions are the same basic Honda Accord, but each offering has extra features (*e.g.* power steering, sunroof, satellite radio, *etc.*). Every Accord is the same base model (program) but with different upgraded features. One has a base model (program) and one adds a feature here or there. One does not change the fundamental nature of the program.

The Hendricks citation on the other hand deals with different modes of transportation. In the analogous Hendricks, one could purchase a bicycle, a motorcycle, a car, or a jet plane. Hendricks doesn't offer car models (programs) with different features, but instead different modes of transportation (channels) with different abilities.

Hendricks shows that anytime a user turns on channel 37 (as an illustrative channel number) any programs displayed on channel 37 will be in HDTV format. If the user does not want HDTV, the user should avoid channel 37, or, more accurately, if the user doesn't want to pay for HDTV, channel 37 will be unavailable. In Hendricks, if the user wants HDTV, the user must buy a new tier of channels. Applicants, on the other hand, show that if the user wants to watch *Titanic*, the user will have the option (in one embodiment) of seeing it in HDTV, analog,

¹ Applicants respectfully note that even if an attempt was made to use this definition of "channel" as "group of programs" it would not be acceptable under M.P.E.P. § 2111.

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

digital, or other methods. The user's feature decision not based on the channel but on the individual program.

For at least the reasons stated above, Applicants respectfully contend that Hendricks fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

1.2.2. Upgraded Media Features

In the Applicants specification, page 6, lines 7 & 8, an “upgraded media feature” is defined as “Upgraded media features included, but are not limited to, a wide variety of audio, video, and interactive effects.” Applicants Fig. 5 provides a graphical example of this. In the Figure there is a program, *e.g. Titanic*, and additional features, *e.g. surround sound, HDTV, etc.*, are offered. The “upgraded media feature” is closely associated with an individual program. In contrast, Hendricks offers no additional features, but instead additional channels that have different capabilities or features. These features are associated, not with individual programs, as the Applicants claim requires, but with entire channels.

As an example, an embodiment of the Applicants’ disclosed subject matter may include selling *Titanic* with or without surround sound and the right to record it. It is respectfully asserted that Hendricks does not teach selling *Titanic* with or without surround sound and the right to record it, but instead Hendricks teaches selling the channel packages that includes a plurality of channels. In an embodiment of Hendricks, if a user wishes to watch *Titanic*, they must buy a channel tier that includes HBO.

As cited by the PTO, some of the Hendricks channels may include an additional media feature, such as for example, HDTV. However, it is respectfully asserted that the mere existence of features is not enough to establish a *prima facie* case for a § 102 rejection. Applicants claim specifies “a plurality of different upgraded media features associated with each entertainment program”. See, Claim 1, lines 3 & 4. Hendricks does not show or describe features associated with programs but channels. See discussion above. Applicants respectfully contend that

Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

Hendricks fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102 for at least this reason alone.

Furthermore, Applicants claim 1 requires “a plurality of different upgraded media features associated with each entertainment program”. Hendricks does not show a plurality of features. Figs 31a and 31b of Hendricks show the feature HDTV. However, this is not a plurality of features but a single feature.

Even, *in arguendo*, if a plurality of features could be shown in Hendricks (for example, HDTV, analog signal, digital signal) these features are not “associated with each ... program”. Instead, Hendricks shows a single feature (either HDTV, or analog, or digital) associated with each channel (See 1.2.1 With Each Entertainment Program above). To meet Applicants' claim language, Hendricks must have multiple features associated with each program. The level of granularity must be at the program level, not the channel level. Applicants respectfully contend that Hendricks fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102 for at least this reason alone.

1.2.3. Conclusion

Applicants respectfully contend that Hendricks fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Claims 2-37 either depend from claim 1, or include a substantially similar and patentably distinct limitation as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.


Appl. No. 09/580,671

Attorney Docket: 042390.P6484D1

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,


Justin B. Scout
Reg. No. 54,431Dated: *Thu Sep 1, 2005*

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967